

In re: Dent  
Serial No. 08/999,604  
Filed: December 26, 1996  
Page 4

### REMARKS

Applicant sincerely appreciates the thorough examination of the present application as evidenced by the Official Action of July 1, 2002. Applicant further appreciates the indication of allowance of Claims 1-29, 33, 43, 46, 48 and 50 and that the rejected claims are not anticipated or rendered obvious by the art of record. Applicant requests that the Examiner consider the rejected claims once more in light of the discussion of the recapture doctrine below.

Various limitations have been applied by the courts on the type of errors that qualify as "error" under Section 251. In general "error" is liberally interpreted and may include an "attorney's failure to appreciate the full scope of the invention." *In re Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995 (Fed. Cir. 1993)(quoting *In re Wilder*, 736 F.2d 1516, 1519 (Fed. Cir. 1984)). However, the recapture rule "prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims." *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370-71 (Fed. Cir. 2001)(quoting *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997)).

The process for application of the recapture rule was more fully described in *Pannu*:

Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." "The second step is to determine whether the broader aspects of the reissued claim related to the surrendered subject matter." Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

*Pannu*, 258 F.3d at 1371 (citations omitted).

With respect to the third step in the recapture analysis, the Court in *Mentor* stated that the added limitations relied on as narrowing the claim must narrow the claim in a "material respect compared with their broadening." *Mentor*, 998 F.2d at 996 (emphasis added); see also, *Clement*, 131 F.3d at 1471 (finding recapture applied for claim "broader than it is narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution.")(emphasis added).

In re: Dent  
Serial No. 08/999,604  
Filed: December 26, 1996  
Page 5

The third step was further analyzed in *Hester Industries v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998). The court in *Hester* stated that the recapture rule may be overcome "when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects." *Hester*, 142 F.3d at 1482-83 (emphasis added).

Another recapture case, *Ball Corp. v. United States*, 729 F.2d 1429 (Fed. Cir. 1984), preceded the development of the three step test described above. Nonetheless, the court in *Ball* stated that, when determining whether the applicant had made a deliberate decision that cancelled claims were unpatentable required a focus "on the scope of the claims, not on the individual feature or element purportedly given up during prosecution of the original application." *Ball*, 729 F.2d at 1437.

The Official Action further notes that Applicant has also relied on *B.E. Meyers & Co. v. United States*, 56 U.S.P.Q.2d 1110 (Ct. Cl. 2000) ("Meyers"). (Official Action, p. 7). The Official Action states that Meyers does not apply as "it appears that these limitations were, in fact, surrendered for reasons of patentability evidenced from the '335 file wrapper history. Accordingly, the claims are rejected." (Official Action, p. 7). However, such a conclusion is contrary to the holding in Meyers. In Meyers, the patentee presented claims during reissue that did not recite any "pulsing circuitry" but, instead, were directed to a lens apparatus "independent of whatever type of pulsing circuitry might be used." *Meyers*, 56 U.S.P.Q.2d at 1116. During original prosecution, claims including a generic pulsing circuit had been amended to add limitations to the pulsing circuit to overcome prior art rejections. *Meyers*, 56 U.S.P.Q.2d at 1115. Meyers held that this was not recapture as the patentee was not trying to "protect any type of pulsing circuit design that is taught by the prior art. *Meyers*, 56 U.S.P.Q.2d at 1116.

Thus, as with presently rejected independent Claims 30, 31, 34, 35, 44 and 51-56 related to paging methods, systems and mobile stations, Meyers found that claims directed to a distinct invention were not barred during reissue under the recapture doctrine. This is consistent with the Court of Appeals for the Federal Circuit cases discussed above. As is clear from the amendments to Claims 29, 33 and 43 that overcome the previous recapture

In re: Dent  
Serial No. 08/999,604  
Filed: December 26, 1996  
Page 6

rejections of those claims, the limitations the Official Action asserts should be added relate to determining "a phase of the calling channel signal" when decoding a received signal and to "using said phase of the calling channel to extract traffic information." However, Applicant submits that the Official Action has failed to establish any basis for how or why such recitations should be applied to the paging claims. Accordingly, the rejections of the paging claims under Section 251 should be withdrawn.

Independent Claims 45, 47 and 49 also stand rejected under Section 251. Applicant submits that the amendments above obviate these rejections by reintroducing recitations the Official Action asserts are required. Accordingly, Applicant requests withdrawal of all the pending rejections.

Applicant further notes that the Official Action cites to various cases of the Court of Appeals for the Federal Circuit in support of the Section 251 rejections. However, each of these cases is merely cited for general rules related to the recapture doctrine that simply are not determinative in the present case. For example, *In re Wilder* is cited for the proposition that every error is not correctable by reissue. (Official Action, p. 8). Applicant does not disagree, but submits that such a proposition fails to provide a basis for rejecting the claims pending in the present application. As to the remaining details of *In re Wilder*, Applicant notes that the dicta in this 1984 case is of, at most, questionable value in light of the more recent cases discussed above by Applicant.

As to the *In re Hounsfield* case, Applicant notes that the Official Action relies on this case to assert that the test for reissue claims is "whether the reissue claims are for the same invention as that disclosed in the original patent." (Official Action, p. 8). However, the *In re Hounsfield* involved an appeal of a Patent Office rejection of a reissue based on an "intent to claim" theory. The court in *In re Hounsfield* specifically rejected this grounds and stated that there is no such "independent basis for denying a reissue application." *In re Hounsfield*, 699 F.2d 1320, 1323-24 (Fed. Cir. 1983). Furthermore, the Official Action's application of *In re Hounsfield* to the present application is inconsistent with the Court of Appeals for the Federal Circuits recent description of the reissue process as follows:

A patentee who inadvertently fails to claim disclosed subject matter, however, is not left without remedy. Within two years from the grant of the original patent, a patentee may file a reissue application and attempt to enlarge the

In re: Dent  
Serial No. 08/999,604  
Filed: December 26, 1996  
Page 7

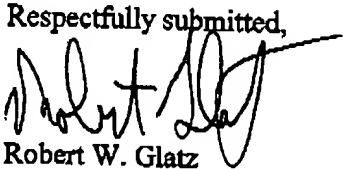
scope of the original claims to include the disclosed but previously unclaimed subject matter.

*Johnson & Johnston Assoc. v. R.E. Service Co.*, 62 U.S.P.Q.2d 1225, 1231 (Fed Cir. 2002). Thus, *In re Hounsfield* also provides no support for the present Section 251 rejections.

Finally, the Official Action cites to *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556 (Fed. Cir. 1989) for the proposition that "nonintentional failure to obtain claims narrower in scope than the patent claims is not, as such, 'error.'" (Official Action, p. 8). As an initial matter, Applicant fails to understand how the Official Action contends such a legal rule relates to the present rejections as this is a broadening reissue application. Furthermore, the issue in the Hewlett-Packard case related to the sufficiency of a reissue declaration and whether a narrowing amendment could be based on an asserted error that the patentee had claimed less than he had a right to claim. *Hewlett-Packard*, 882 F.2d at 1564-65. As such is simply not the case here, Applicant submits that Hewlett-Packard, like the other cases cited in the Official Action, fails to support the present rejections.

#### CONCLUSION

Applicant respectfully submits that, for the reasons discussed above and in Applicant's previous responses, the claims as amended satisfy the requirements of 35 U.S.C. § 251. Accordingly, Applicant respectfully requests entry of this Amendment and allowance of all the pending claims and passing this application to reissue.

Respectfully submitted,  
  
Robert W. Glatz  
Registration No. 36,811

Customer Number:



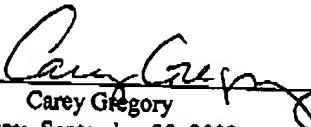
20792  
PATENT TRADEMARK OFFICE

In re: Dent  
Serial No. 08/999,604  
Filed: December 26, 1996  
Page 8

**Certificate of Mailing under 37 CFR 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on September 30, 2002.

Signature:

  
Carey Gregory

Date of Signature: September 30, 2002

276022

In re: Dent  
Serial No. 08/999,604  
Filed: December 26, 1996  
Page 9

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

Please replace Claims 45, 47 and 49 with the following:

45. (Amended) A method for transmitting control information and user traffic signals from a first base station to a plurality of mobile stations in a code division multiple access communication system comprising the steps of:

coding control information using a spread spectrum code unique to control information to form a calling channel signal, wherein a duration of each of a succession of data blocks in the calling channel signal is equal to a duration of a speech coder's analysis period and wherein said control information carries information for a specified group of mobile stations only at predetermined times;

coding each user traffic signal using a spread spectrum code unique to each traffic signal;

adding said calling channel signal and said coded traffic signal to obtain a composite signal;

modulating said composite signal on a radio frequency carrier to form a radio frequency signal; and

transmitting said radio frequency signal to said plurality of mobile stations with an associated phase as received at ones of the plurality of mobile stations for use by the receiving ones of the plurality of mobile stations in extracting traffic signals intended for the receiving ones of the plurality of mobile stations.

47. (Amended) A code division multiple access communication system for transmitting control information and user traffic signals from a first base station to a plurality of mobile stations comprising:

means for coding control information using a spread spectrum code unique to control information to form a calling channel signal, wherein a duration of each of a succession of data blocks in the calling channel signal is equal to a duration of a speech coder's analysis period and wherein said control information means carries information for a specified group of mobile stations only at predetermined times;

In re: Dent  
Serial No. 08/999,604  
Filed: December 26, 1996  
Page 10

means for coding each user traffic signal using a spread spectrum code unique to each traffic signal;

means for adding said calling channel signal and said coded traffic signal to obtain a composite signal;

means for modulating said composite signal on a radio frequency carrier to form a radio frequency signal; and

means for transmitting said radio frequency signal to said plurality of mobile stations with an associated phase as received at ones of the plurality of mobile stations for use by the receiving ones of the plurality of mobile stations in extracting traffic signals intended for the receiving ones of the plurality of mobile stations.

49. (Amended) A code division multiple access communication system for transmitting control information and user traffic signals from a first base station to a plurality of mobile stations comprising:

a calling channel modulation generator that is configured to code control information using a spread spectrum code unique to control information to form a calling channel signal, wherein a duration of each of a succession of data blocks in the calling channel signal is equal to a duration of a speech coder's analysis period and wherein the control information carries information for a specified group of mobile stations only at predetermined times;

a traffic channel modulation generator that is configured to code each user traffic signal using a spread spectrum code unique to each traffic signal;

a summing network that is configured to add the calling channel signal and the coded traffic signals to provide a composite signal;

a mixer that is configured to modulate the composite signal on a radio frequency carrier to form a radio frequency signal; and

a transmit power amplifier that is configured to transmit the radio frequency signal via an antenna to the plurality of mobile stations with an associated phase as received at ones of the plurality of mobile stations for use by the receiving ones of the plurality of mobile stations in extracting traffic signals intended for the receiving ones of the plurality of mobile stations.

--END--